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Application No.: 10/825,972

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Applicant: Andrew Michael Allen et al.

Examiner: Muthuswamy Ganapathy
Manoharan

Title: METHOD AND APPARATUS FOR DYNAMIC GROUP ADDRESS CREATION

Docket No.: 291010-00036

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APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner of Patents

P.O. Box 1450

Alexandria, V.A. 22313-1450

Dear Sir/Madam:

This Appeal Brief is submitted pursuant to the Notice of Appeal received in the U.S. Patent and Trademark Office on May 15, 2008, and in support of the appeal from the final rejection(s) set forth in the Office Action mailed on December 12, 2007. The fee for filing a brief in support of an appeal will be charged to Eckert Seamans Cherin & Mellott, LLC American Express Credit Card during the electronic transmission process.

If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. § 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 02-2556. A duplicate copy of this sheet is attached.

Table of Contents

Real Party in Interest begins on page 3.

Related Appeals and Interferences begins on page 4.

Status of Claims begins on page 5.

Status of Amendments begins on page 7.

Summary of Claimed Subject Matter begins on page 8.

Grounds of Rejection to be Reviewed on Appeal begin on page 13.

Arguments begin on page 15.

Claims Appendix begins on page 36.

Evidence Appendix begins on page 48.

Related Proceedings Appendix begins on page 49.

Real Party in Interest

The real party of interest is Research In Motion Limited, by virtue of an assignment executed by the inventors in favor of Research In Motion Limited, recorded at Reel/Frame 015166/0187.

Related Appeals and Interferences

None.

Status of Claims

Pursuant to the Examiner's Final Office Action mailed December 12, 2007, the status of the claims is as follows:

Claims 1-64 were previously cancelled.

Claims 65-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114, and 116 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348);

Claims 72 and 73 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Dorot* (WO 2001/097539);

Claims 76-78 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Griffin* et al. (U.S. Patent No. 7,072,941);

Claim 85 stands rejected as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Laiho* (U.S. Patent No. 6,097,942);

Claim 86 stands rejected as being unpatentable under 35 U.S.C. § 103 (a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Chandhok* et al. (U.S. Patent Publication No. 2004/0198376);

Claims 89-92 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Leigh* et al. (U.S. Patent No. 5,535,426);

APPEAL BRIEF
Application Serial No. 10/825,972

Claim 93 stands rejected as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Requena* (U.S. Patent Publication No. 2002/0126701);

Claims 94-102 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348); and

Claims 103-112 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Dorot* (WO 2001/097539).

The rejections of Claims 65-117 are being appealed.

Status of Amendments

No amendments were presented subsequent to the Examiner's Final Action of December 12, 2007. No amendments have been made since a new claim set was submitted on September 5, 2006.

Summary of Claimed Subject Matter

The present claims are directed to a method and apparatus for dynamically creating group addresses for facilitating communications among a group of users. (Paragraph 0001) More specifically, the present claims provide for methods and an apparatus for facilitating dynamic group creation for push-to-talk over Cellular (PoC) group communication sessions, instant messaging sessions, chat, and other communications. (See Paragraph 0001)

In one embodiment, the method comprises receiving (See 504, Paragraph 0062) at least one rule defining a member of the dynamic group in association with a group address and populating the dynamic group with members from the mobile stations (105, Paragraph 0018) determined in accordance with the at least one rule. (Paragraph 0017) Rules may be defined with reference to presence and/or location information available for the mobile stations (105, Paragraph 0018). Such information may be published on behalf of the stations (105, Paragraph 0018) to one or more servers (137, Paragraph 0027) adapted to identify mobile stations (105, Paragraph 0018) matching the rules. (Paragraph 0017) The method may comprise subscribing to the servers (137, Paragraph 0027) to obtain the matching mobile stations (105, Paragraph 0018) with which to populate dynamic group addresses. (Paragraph 0017)

Independent Claim 65 defines a method (FIGS. 5 and 6) of creating and managing a group of mobile stations (105, Paragraph 0018) for a communication session in a communications network (104, Paragraph 0018). The communication session is one in which users of respective mobile stations (105, Paragraph 0018) communicate with one another. (Paragraphs 0010; 0060) The method comprises: publishing information (See 506, Paragraph 0063) about one or more particular users of respective mobile stations (105, Paragraph 0018) to the communications network (104, Paragraph 0018) (Paragraphs 0010; 0048; 0054; 0063); and receiving (See 504, Paragraph 0062) at least one rule defining a member of the group, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations (105, Paragraph 0018) (Paragraph 0010; 0062), the at least one rule being received in association with a group address (See Paragraphs 0043; 0048; 0052; 0053;

0057); and dynamically populating the group with members, the populating comprising (Paragraphs 0010; 0080): determining mobile stations (105, Paragraph 0018) having respective users with published information on the communications network (104, Paragraph 0018) that matches the published information criteria of the at least one rule (Paragraphs 0044; 0072-0081); and populating the group with the mobile stations (105, Paragraph 0018) having respective users with published information on the communications network (104, Paragraph 0018) that matches the published information criteria of the at least one rule (Paragraphs 0010; 0080).

Independent Claim 94 defines a server (137, Paragraph 0027 FIGS. 1, 3, 4) for creating and managing a group of mobile stations (105, Paragraph 0018) for a communication session in a communications network (104, Paragraph 0018). The communication session is one in which users of respective mobile stations (105, Paragraph 0018) communicate with one another. (Paragraphs 0010; 0060) The server (137, Paragraph 0027) comprises: a communication system (100, Paragraph 0018) for transmitting and receiving messages via the communications network (104, Paragraph 0018); a processor (238, Paragraph 0033) coupled to the communication system (100, Paragraph 0018) for processing messages; and memory (262, Paragraph 0032) coupled to the processor (238, Paragraph 0033) for storing instructions to configure the processor (238, Paragraph 0033 and FIGS. 1 and 2) to : publish information about one or more particular users of respective mobile stations (105, Paragraph 0018) to the communications network (104, Paragraph 0018) (See also Paragraphs 0010; 0048; 0054; 0063); and receive at least one rule defining a member of the group, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations (105, Paragraph 0018) (Paragraphs 0010; 0062), the at least one rule being received in association with a group address (See also Paragraphs 0043; 0048; 0052; 0053; 0057); and dynamically populate the group with members, the populating comprising (Paragraphs 0010; 0080): determining mobile stations (105, Paragraph 0018) having respective users with published information on the communications network (104, Paragraph 0018) that matches the published information criteria of the at least one rule (Paragraphs 0044; 0072-0081); and populating the group

with the mobile stations (105, Paragraph 0018) having respective users with published information on the communications network (104, Paragraph 0018) that matches the published information criteria of the at least one rule (Paragraphs 0010; 0080).

Independent Claim 103 defines a method of operating a server (137, Paragraph 0027) for creating and managing a group of mobile stations for a communication session in a communications network (104, Paragraph 0018). The communication session is one in which users of respective mobile stations (105, Paragraph 0018) communicate with one another. (Paragraphs 0010; 0060) The method comprises: publishing information (See 506, Paragraph 0063) about one or more particular users of respective mobile stations (105, Paragraph 0018) to the communications network (104, Paragraph 0018 Paragraphs 0010; 0048; 0054; 0063); and receiving (See 504, Paragraph 0062) at least one rule defining a member of the group, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations (105, Paragraph 0018) (Paragraphs 0010; 0062), the at least one rule being received in association with a group address (Paragraphs 0043; 0048; 0052; 0053; 0057); and dynamically populating the group with members, the populating comprising (Paragraphs 0010; 0080): determining mobile stations (105, Paragraph 0018) having respective users with published information on the communications network (104, Paragraph 0018) that matches the published information criteria of the at least one rule (Paragraphs 0044; 0072-0081); and populating the group with the mobile stations (105, Paragraph 0018) having respective users with published information on the communications network (104, Paragraph 0018) that matches the published information criteria of the at least one rule (Paragraphs 0010; 0080).

Independent Claim 104 defines a mobile station (105, Paragraph 0018) for initiating a communication session among other mobile stations (105, Paragraph 0018) in a communication network (FIGS. 1 and 2). The communication session is one in which users of respective mobile stations communicate with one another. (Paragraphs 0010; 0060) The mobile station (105, Paragraph 0018) comprises: a transceiver (108, Paragraph 0019) adapted to transmit and receive messages via the communications network (104, Paragraph 0018); a processor (238, Paragraph 0033) coupled to the

transceiver (108, Paragraph 0019), the processor (238, Paragraph 0033) adapted to process messages; and a memory (262, Paragraph 32) coupled to the processor (238, Paragraph 0033), the memory (262, Paragraph 0032) adapted to store instructions to configure the processor (238, Paragraph 0033) to : transmit, to a server (137, Paragraph 0027) adapted to create and manage a group of mobile stations, information to be published to the communications network (104, Paragraph 0018) about one or more particular users of respective mobile stations (Paragraphs 0010; 0048; 0054; 0063); and transmit at least one rule defining a member of the group to the server (137, Paragraph 0027) (Paragraphs 0010; 0062), the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations (105, Paragraph 0018), wherein the at least one rule is associated with a group address (Paragraphs 0043; 0048; 0052; 0053; 0057) and is used to populate the group with members consisting of mobile stations having respective users having published information about the one or more particular users on the communications network (104, Paragraph 0018) that matches the published information criteria of the at least one rule (Paragraphs 0010; 0080).

Independent Claim 113 defines a method of operating a mobile station (105, Paragraph 0018) for initiating a communication session among other mobile stations (105, Paragraph 0018) in a communication network (FIG.S. 5 and 6). The communication session is one in which users of respective mobile stations (105, Paragraph 0018) communicate with one another (Paragraphs 0010; 0060). The method comprises: transmitting information about one or more particular users of respective mobile stations (105, Paragraph 0018) to a server (137, Paragraph 0027) adapted to create and manage a group for publishing to the communications network (104, Paragraph 0018) (See also Paragraphs 0010; 0048; 0054; 0063); and transmitting the at least one rule defining a member of the group to the server (137, Paragraph 0027) (*See also* Paragraphs 0010; 0062), the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations (105, Paragraph 0018), wherein the at least one rule is associated with a group address (Paragraphs 0043; 0048; 0052; 0053; 0057) and is used to populate the group with

members consisting of mobile stations (105, Paragraph 0018) having respective users having published information about the one or more particular users on the communications network (104, Paragraph 0018) that matches the published information criteria of the at least one rule (Paragraphs 0010; 0080).

Independent Claim 114 defines a method (FIGS. 5 and 6) of creating and managing a group of mobile stations (105, Paragraph 0018) for a communication session in a communications network (104, Paragraph 0018). The communication session is one in which users of respective mobile stations (105, Paragraph 0018) communicate with one another (Paragraphs 0010; 0060). The group is associated with a group address and is defined by at least one rule. (Paragraphs 0043; 0048; 0052; 0053; 0057) The method comprises: publishing an interest of one or more users to the communications network (104, Paragraph 0018) (See also Paragraphs 0010; 0048; 0054; 0063); and determining mobile stations (105, Paragraph 0018) having respective users with an interest published to the communications network (104, Paragraph 0018) which matches an interest for participating in the group defined by the at least one rule (Paragraphs 0044; 0072-0081); and dynamically populating the group with members comprising mobile stations (105, Paragraph 0018) having respective users with an interest published to the communications network (104, Paragraph 0018) which matches the interest for participating in the group defined by the at least one rule (Paragraphs 0010; 0080).

Grounds of Rejection to be Reviewed on Appeal

The Applicant seeks to appeal the following grounds of rejection:

1) whether Claims 65-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114, and 116 are unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348);

2) whether Claims 72 and 73 are unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Dorot* (WO 2001/097539);

3) whether Claims 76-78 are unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Griffin* et al. (U.S. Patent No. 7,072,941);

4) whether Claim 85 is unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Laiho* (U.S. Patent No. 6,097,942);

5) whether Claim 86 is unpatentable under 35 U.S.C. § 103 (a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Chandhok* et al. (U.S. Patent Publication No. 2004/0198376);

6) whether Claims 89-92 are unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Leigh* et al. (U.S. Patent No. 5,535,426);

APPEAL BRIEF
Application Serial No. 10/825,972

7) whether Claim 93 is unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Requena* (U.S. Patent Publication No. 2002/0126701);

8) whether Claims 94-102 are unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348); and

9) whether Claims 103-112 are unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Dorot* (WO 2001/097539).

Argument

Rejection under 35 U.S.C. § 103(a) of Claims 65-71, 74, 75, 79-81, 83, 84, 86, 87, 94-110, 113, 114, and 116 over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348).

Torvinen is concerned primarily with group formation and with location information. *Torvinen* describes a method and system for organizing a group session between members based on their location or proximity and the technical capabilities considered to be necessary to engage in the group session, as determined by the organizing terminal. While *Torvinen* makes brief reference to presence servers, *Torvinen* does not teach or suggest using presence information to dynamically create a group for a group communication session. At page 8 of the Office Action, dated December 12, 2007, the Examiner admits that *Torvinen* does not disclose publishing information about one or more particular users of respective mobile stations to the communications network.

Fraccaroli, on the other hand, is concerned with a wireless communications network comprising a server in a central location storing matching profiles for a plurality of users of the network. The user enters his matching profile using a WEB page, and the matching profile is then stored on a server for later use. In the normal course of events, the matching profile need only be entered once (see, for example, Paragraph 0055). Each matching profile corresponds with a respective mobile unit using the same identification information (ID) of the respective mobile unit utilized for carrying out phone calls. The server has a customizable variable matching algorithm and probes the matching profiles corresponding to the respective mobile units in a cellular telephone phone or group of cellular telephones for a match when a new cellular unit subscribes into the cell or group of cells. When there is a match of matching profiles, the *two* persons are advised of each other and they may then initiate a telephone call to contact each other if they wish (see, for example, Paragraph 0057).

There are multiple deficiencies in the Examiner's rejections set forth on pages page 7-14 of the Office Action, dated December 12, 2007. That is, the cited art does not disclose what the Examiner states it discloses, *Fraccaroli* is non-analogous art, and even

if *Fraccaroli* was combinable with *Torvinen*, such a combination does not disclose all the elements recited in the claims of the present application, and the Examiner has not properly supported the rejection under the standard set forth in *KSR International Co. v. Teleflex Inc.*, __ U.S. __, 2007 WL 1237837 (2007).

The Cited Art Does Not Disclose What the Examiner States it Discloses.

With regard to the first point, the Examiner states that *Fraccaroli* teaches, in an analogous art, a method of creating and managing a group of mobile stations for a communication session in a communications network and publishing information about one or more particular users of respective mobile stations to the communications network. The Examiner cites Paragraph 0005 to support this position.

Paragraph 0005 of *Fraccaroli* is reproduced below:

Several methods and systems currently exist for generally matching people having similar interests or other reason for willing to be put in contact with each other. For example, computer dating services match people using a large database having a profile for each one of their customers. Each customer's profile contains personal information such as age, race, marital status, gender, sexual orientation, religion, height, weight, color of eyes and/or hair, smoking habits, education, interests, etc. This matching profile is used to match the customer with others. In addition to their own matching profile, each customer can also submit a request which contains their preferences for a match with the matching profiles of other customers. In response to the request, the computer dating service searches the database for matching profiles which match the preferences in the request and then informs the requesting customer of the selected matches, if any. The match is typically recorded by some sort of a printed report.

With respect, Paragraph 0005 of *Fraccaroli* does not teach or suggest any of what the Examiner states. Paragraph 0005 does not discuss a method of any sort for creating and managing a group of mobile stations for a communication session. Paragraph 0005 neither mentions a communications network, nor discusses publishing information about one or more particular users of respective mobile stations to the communications

network. Paragraph 0005 simply recites, at a high level, the workings of a conventional computer matching service.

At page 3 of the Final Office Action of December 12, 2007, the Examiner simply stated, again, that *Fraccaroli* is relied upon for “publishing information about one or more particular users of respective mobile stations to the communication network.” Rather than citing Paragraph 0005 as in the June 18, 2007 Office Action, the Examiner then pointed to Paragraph 0056, to support this assertion. However, Paragraph 0056 merely states that:

In an alternative embodiment, the servers 106 can be deleted and the respective matching engines 107 can be associated with server 109 instead of with servers 106. This embodiment expands the range of a single matching engine so that it can be, for example, national or international in range and also avoids the need to install separate servers at each HLR 105. In such an embodiment, each HLR 105 checks the USER ID of each user in its service areas 103 and forwards the USER ID to server 109 where matching is to be performed for that USER ID. Such an embodiment is optimal for a matching service for customers who frequently travel to different cities or countries and wish to be matched with others in that city or country who have similar interests. Depending on the amount of traffic and matching performed, there may be too much processing required for a single matching engine 107, in which case, the matching engine will be distributed as exemplified in the embodiment shown in FIG. 1. The distributed system shown in FIG. 1 is also preferable for networks in which different areas have different standards or protocols. The servers 106 may be different from each other and the profiles transition 108 may provide different transitions so that the same common profile in Internet server 109 could be provided to different networks.

Again, Paragraph 0056 of *Fraccaroli* does not state what the Examiner alleges it does. Paragraph 0056 of *Fraccaroli* discusses an embodiment where the matching engine is distributed, or spread across more than one server. Even if *Fraccaroli* discloses bidirectional information exchange between the handsets 102 and the servers 106, and even if the matching engine is distributed, *Fraccaroli* still does not teach or suggest publishing information about one or more particular users of respective mobile stations to the communications network.

As previously pointed out, *Fraccaroli* operates based on a saved matching profile, which is not published and is not associated with a group address. The saved matching profile of *Fraccaroli* is not sent from the handset 102 to the server 109 each time the method operates, as it would be if it were published to the communications network, as claimed. Rather, the matching profile of *Fraccaroli* is already present on a server of the communications network.

Paragraph 0055 of *Fraccaroli* states:

At some point in time, HLR 105 provides a request to server 109 for the matching profiles of each user as described above. Preferably, the request from HLR 105 is made as soon as the user is registered in HLR 105. The matching profile (and request profile including preferences) for the user is read out of server 109 in response to the request, reformatted in profiles transition 108, and stored in server 106 corresponding to the requesting HLR 105. The matching profile of the newly added user is then compared with the respective matching profiles of the other users located in the same location area (which may be a cell, group of cells, or location area less than the area of a cell) as the newly added user.. (emphasis added)

Paragraph 0055 of *Fraccaroli* provides the opposite of what the Examiner is alleging *Fraccaroli* discloses, namely that the matching profile for the user is already saved in the server 109 of the communications network.

The Examiner further states at page 4 of the Final Office Action of December 12, 2007, with reference to *Fraccaroli*, that “two people can form a group.” With this statement, the Examiner has failed to appreciate the meaning of the word “group” as used in the description and the claims of the present application. First, as set forth in Paragraphs 0005 and 0006 of the present application, a “group” is identified in the context of one person contacting more than one other person. More specifically, Paragraph 0005 recites that, “a user may communicate ... to a group of users,” and Paragraph 00006 states that, “an individual may wish to ... communicate with other persons.” That is, the recited invention is structured to operate with a “group” having

more than two people; the user/individual and other users/persons. A further appreciation of the technical meaning of the term group can be gained, for example, from the preamble of Claim 65, which recites a method of creating and managing a group of mobile stations for a communication session in a communications network, the communication session being one in which users of respective mobile stations communicate with one another. It is further noted that, while the disclosed system is structured for use by a “group” as defined herein, due to circumstances in which the present invention is used, a “group” may only comprise of two people, *e.g.*, when only two people in a geographic location fit the group profile. Thus, while the method may be applied to only two users, the recited system, unlike *Fraccaroli*, is structured to connect a group of more than two people.

As such, the term “group” refers to a virtual electronic group. A “group,” as recited in the present claims, does not include two people physically standing side by side, which is the end result of the method of *Fraccaroli*, which merely provides two people with contact information to contact each other. No group is ever formed in the teachings of *Fraccaroli*, within the meaning given to that term by the present application.

***Fraccaroli* Is Non-Analogous Art.**

With regard to the second point, it is noted that MPEP § 2141.01(a) states, “in order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention is concerned.” *Id.*, citing, *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir 1992). In *Oetiker*, which concerned mechanical devices, the Applicant claimed an improvement in a hose clamp. The claimed hose clamp differed from the prior art in the presence of a preassembly “hook,” which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The claims were rejected on the basis of a reference which disclosed a hook-and-eye fastener for use in garments. The rejection was based on the rationale that all hooking problems are analogous. The rejection, however, was overturned when the Court held the reference was not within the field of

Applicant's endeavor and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. That is, in a mechanical case involving simple hooks, the "field of invention" identified by the examiner, "hooks," was found to be in error and the court required a more narrowly defined field.

Analogous fields in the electrical arts are not broad categories. For example, it has been held that similar, or even identical components, may be used in different manners and that art that relates to a component in one environment may not be used as a prior art reference under 35 U.S.C. § 103(a) in relation to the same type of component used in a different environment. That is, as set forth in MPEP § 2141.01(a), a reference relating to single, in-line memory modules (SIMMs) for industrial use was held not to be analogous prior art for an invention relating to SIMMS in personal computers. *Id.*, citing, *Wang Laboratories, Inc v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993).

Fraccaroli discloses a matching mechanism, where two people are matched and provided with contact information for each other based on a saved matching profile when they happen to be located in the same cellular cell. Based on this disclosure, the "field of art" identified by the examiner is "matching persons through their mobile stations on the network." "Matching people," especially wherein the number of people matched is two, does not concern group formation. Therefore, *Fraccaroli* does not concern group formation. The claims of the present application, however, recite a "method of creating and managing a group," or a related apparatus. Thus, Applicants contend that the relevant field of art must relate to "group formation" as opposed to "matching people." Further, if identical components used in different environments, *e.g.*, SIMMs used in industrial setting vs. SIMMS used in personal computers, are considered "non-analogous," it is without question that, based on the foregoing, *Fraccaroli's* disclosure of "matching people" is non-analogous art for the present application relating to "group formation."

Torvinen and Fraccaroli Cannot Be Combined as Suggested by the Examiner

Moreover, *Torvinen* is concerned with allowing the creator of a group or organizer of an event to flexibly create event location-based services (Paragraph 0030). *Fraccaroli* does not meet this objective at all. Rather, in *Fraccaroli*, the HLR server of a cellular network may provide information to two subscribers allowing them to contact each other if it is determined that a match exists, based on their locations and a previously-entered matching profile. Realistically, the system of *Fraccaroli* may not provide notifications to a user for days if no matches occur, which is a condition that entirely fails to meet the needs of the event location-based services taught by *Torvinen*. In this respect, *Fraccaroli* and *Torvinen* substantially diverge and explicitly teach away from each other.

As *Torvinen* and *Fraccaroli* explicitly teach away from each other. Thus, there can be no reasonable expectation of success for one skilled in the art to use the teachings of *Torvinen* and *Fraccaroli* to arrive at the presently claimed subject matter.

Combination of *Fraccaroli* with *Torvinen* Still Fails to Disclose all the Elements Recited in the Claims.

Further, even if the cited art was combinable, *Fraccaroli* fails to cure the deficiencies of *Torvinen*. *Fraccaroli* concerns matching individuals based on a previously-entered, saved profile and then notifying those individuals of the match by providing information that allows the individuals to establish contact between themselves. In this sense, the method of *Fraccaroli* is akin to the automated matching (e.g., dating) service mentioned at Paragraph 0005, which aims to match people in pairs - not create groups having multiple members.

This is in direct contrast to the presently claimed subject matter, which recites a method comprising the steps of **publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at**

least one rule for defining a member of a group. The at least one rule is **defined by criteria comprising published information about respective users of mobile stations** and is received **in association with a group address**. In other words, as presently claimed, group membership and the rule for defining group membership is dependent, at least in part, on the published information about the users of the mobile stations (*i.e.*, the published information is also published before group creation and is used to facilitate group creation). In contrast, *Fraccaroli* operates based on a saved matching profile, which is not published and is not associated with a group address, and the registration information of the cellular network to which the cellular phones of the users belong. No rules for defining the members of the group are received during the matching process of *Fraccaroli*. Therefore, even if *Fraccaroli* is properly combinable with *Torvinen*, which Applicants submit is not the case, *Fraccaroli* and *Torvinen* still fail to teach or suggest each and every feature recited in pending Claim 65.

The Examiner Has Not Properly Supported the 35 U.S.C. § 103 Rejection and has Failed to Establish a *prima facie* Case of Obviousness.

(a) The Examiner has not Properly Supported the 35 U.S.C. § 103 Rejection

Further, with regard to the determination of obviousness under 35 U.S.C. § 103, the Supreme Court has recently stated that:

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, *it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does*. This is so because inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. (Emphasis added.)

KSR International Co. v. Teleflex Inc., __ U.S. __, 2007 WL 1237837 (2007), (Slip Opinion at 14-15).

In addition, the Supreme Court also noted that:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, *this analysis should be made explicit*. See *In re Kahn*, 441 F.3d 977, 988 (Fed Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness*”). (Emphasis added.)

Id., at __ (Slip Opinion at 14).

It is noted that the Supreme Court included an extended discussion reciting the nature of the inventions disclosed in the prior art and then several paragraphs identifying the rationale and reasons that the cited art could be combined and why one skilled in the art would make such a combination. *Id.*, at __ (Slip Opinion at 3-6, 20-22).

With regard to combining known elements of an invention, the Supreme Court further stated that, “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.*, at __ (Slip Opinion at 14). This holding comports with *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), which held that although some of the cited references may individually have some of the claimed inventions’ features, “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.” *Id.* at 1075. Instead, to reach the proper conclusion under § 103:

the decision maker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether...the claimed invention as a whole would have been obvious at *that* time to *that* person.

Id. at 1073-74.

The Examiner has not properly supported the rejection under 35 U.S.C. § 103(a) and under *KSR International*. At multiple locations in the Office Action, the Examiner identifies a first element in *Torvinen* and a second element in *Fraccaroli* and then states that these elements may be combined. For example, at page 3 of the June 18, 2007, Office Action, the Examiner states that, “*Torvinen teaches a method of creating and managing a group of mobile stations for a communication session in a communications network ..*” (emphasis added). On pages 3-4 of the of the June 18, 2007, Office Action, the Examiner states that, “*Fraccaroli teaches . . . publishing information about one or more particular users of respective mobile stations to the communications network.*” (emphasis added). The Examiner then concluded that, “it would be obvious to one of ordinary skill in the art at the time of invention to use a **method of creating and managing a group of mobile stations for a communication session in a communications network publishing information about one or more particular users of respective mobile stations to the communications network.**”(emphasis added). Thus, the Examiner has merely identified selected elements (*e.g.*, [X and Y] from the cited art, and stated that, “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use [X]/[Y].” The Examiner does not, however, provide any other analysis as to how or why such a combination would be made. Each specific rejection contains a similar conclusory sentence.

Applicants believe that such single conclusory sentences for each detailed rejection are not sufficient to qualify as an “articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness” and that the Examiner has failed to make the analysis *explicit*. Such an explicit analysis would be similar to the analysis provided by the Supreme Court in *KSR International*, which noted the elements in question and detailed how one skilled in the art would assemble, and even alter, these elements to arrive at the invention recited in the patent at issue. Moreover, the Court in *KSR International* specifically states that a mere conclusory statement cannot sustain a determination of obviousness.

At page 6 of the Final Office Action of December 12, 2007, with regard to the argument under *KSR International Co. v. Teleflex Inc.*, the Examiner states that:

In response to applicant's arguments, the recitation "a method of creating and managing a group of mobile stations for a communication session in a communications network" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67,190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150,152,88 USPQ 478,481 (CCPA 1951).

With respect, the Applicants are unsure of how this statement addresses the Examiner's failure to present an "articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness." That is, in the Response to the June 18, 2007 Office Action, Applicants quoted the Examiner's words from the June 18, 2007 Office Action, wherein the Examiner set forth the alleged relevant elements disclosed in the cited art and provided a motivation, albeit a one-sentence motivation, as to why one skilled in the art would make such a combination. In the December 12, 2007 Final Office Action, the Examiner then stated that one of the elements that is disclosed by the prior art is irrelevant as it is merely recited in the preamble. Accordingly, the Examiner has admitted that the only cited element from *Torvinen*, namely "a method of creating and managing a group of mobile stations for a communication session in a communications network," is not relevant to the present claims as that recitation is in the preamble to the present claims. Thus, the Examiner's reliance on *Torvinen* must also be irrelevant, and the rejection under 35 U.S.C. § 103(a) is improper.

Moreover, the Examiner has failed to address the substance of Applicant's arguments; namely, that a rejection under 35 U.S.C. § 103(a) and under *KSR International* requires an "articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness" and that articulated reasoning must be explicit. As stated in *KSR International*, a mere conclusory statement cannot sustain a

determination of obviousness. In the December 12, 2007 Final Office Action, the Examiner has, essentially, admitted that one of the cited references is irrelevant. Such a statement does not provide the required explicit articulated reasoning to support the combination(s) set forth in the prior Office Action. As such, the Examiner has failed to properly support the rejection under 35 U.S.C. § 103(a) and under *KSR International*.

Applicants believe that the Examiner's inability to explain why one skilled in the art would modify the teachings of *Torvinen* with the teachings of *Fraccaroli* is expected. As the Applicants previously pointed out, *Fraccaroli* is non-analogous art and cannot be combined with *Torvinen*. Further, the system of *Fraccaroli* may not provide notifications to a user for days if no matches occur, which is a condition that entirely fails to meet the needs of the event location based services taught by *Torvinen*. In this respect, *Fraccaroli* and *Torvinen* substantially diverge and explicitly teach away from each other. In the present case, where the teachings of the cited art explicitly and significantly diverge, *Torvinen* and *Fraccaroli* cannot possibly be considered analogous art under the law laid out in *Wang Laboratories, Inc v. Toshiba Corp*.

(b) The Examiner Impermissibly Applies Hindsight in His Obviousness Analysis

In the Final Office Action of December 12, 2007, the Examiner seems to allege that *Fraccaroli* is in the field of the Applicants' endeavor because (1) *Fraccaroli* concerns matching people through their mobile stations and that (2) *Fraccaroli* is properly combinable with *Torvinen* because *Fraccaroli* is relied upon for teaching "publishing information about one or more particular users of respective mobile stations to the communication network," and this way, the profile information will be available locally to one or more servers. The Examiner stated that the Applicants' application teaches "such information may be published on behalf of the stations to one or more servers adapted to identify the mobile stations matching the rules." As such, the Examiner appears to be deriving the motivation to combine *Torvinen* and *Fraccaroli* from the Applicants' teaching in the pending application and using the Applicants' description as a guide to reconstructing the Applicants' invention using the available

prior art references. This is a classic case of the impermissible use of hindsight. *See, In re Fine*, 837 F.2d 1071 at 1075, 5 USPQ2d 1596 holding that the use of hindsight is strictly impermissible.

The Examiner diverts attention from this impermissible use of hindsight by citing *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) which noted that “it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper.” However, merely citing a case does not show that the Examiner has followed the holding of that case. That is, while citing *In re McLaughlin*, the Examiner has not presented any evidence as to what “was within the level of ordinary skill at the time the claimed invention was made” and how such teaching could be combined. Thus, despite citing *In re McLaughlin*, it appears that only reason the Examiner believes *Torvinen* and *Fraccaroli* would be combinable is because the Examiner is using the Applicants’ description as a guide to reconstructing the Applicants’ invention using the available prior art references. Accordingly, the Examiner is in error because, contrary to *In re McLaughlin*, the Examiner has not shown that combination of *Torvinen* and *Fraccaroli* was based only knowledge which was within the level of ordinary skill at the time the claimed invention was made and the combination is, in fact, based upon pure hindsight.

Further, the Examiner has not provided any motivation found within the cited art for modifying the teachings of *Torvinen* with the teachings of *Fraccaroli*. Further, with regard to the definition of a “group,” it is noted that, as previously argued and as presently claimed, group membership and the rule for defining group membership is dependent, at least in part, on the published information about the users of the mobile stations (*i.e.*, the published information is also published before group creation and is used to facilitate group creation). In contrast, *Fraccaroli* operates based on a saved matching profile, which is not published and is not associated with a group address, and the registration information of the cellular network to which the cellular phones of the

users belong. No rules for defining the members of the group are received during the matching process of *Fraccaroli*.

Claims 103-112 Have Not Been Properly Examined and the Examiner has Failed to Establish a *prima facie* Case of Obviousness for Claims 103-112

It is noted that the Examiner simply groups Claims 103-112 into one large omnibus rejection, at page 21 of the Final Office Action of December 12, 2007. The Examiner has the burden of establishing a *prima facie* case of obviousness with respect to each of the claims. Claims 103-112 contain variations compared to the other claims, yet the Examiner has made no attempt to properly examine Claims 103-112, as required. For example, Claim 104 explicitly recites that the first step in the process that the mobile device is configured to perform involves transmitting, to a server adapted to create and manage a group of mobile stations information to be published to the communications network about one or more particular users of respective mobile stations. *Fraccaroli* does not teach or suggest this feature. As such, the rejection is again improper and should be withdrawn.

In conclusion, it is submitted that *Fraccaroli* and/or *Torvinen*, whether taken alone or in combination, fail to teach or suggest all of the features recited by Claim 65, in the manner described by Claim 65. It is further submitted that *Fraccaroli* and *Torvinen* are not suitable references for citation in a 35 U.S.C. § 103(a) rejection because the references explicitly teach away from each other, as well as the claimed subject matter. It is further submitted that the Examiner has failed to meet his burden of establishing a proper *prima facie* case of obviousness. For all of these reasons, it is submitted that Claim 65 recites patentable subject matter and the rejection should be withdrawn. Independent Claims 94, 103, 104, 113, and 114 were also rejected on the same basis and are patentable for the same reasons. The remaining claims are dependent on Claims 65, 94, 103, 104, 113, and 114 and are patentable for the same reasons.

The Board of Appeals is thus respectfully asked to reverse the claim rejections of Claims 65, 94, 103, 113, 114, and the respective dependent claims under 35 U.S.C. § 103(a).

Rejection of Claims 72, 73, and 103-112 as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Dorot* (WO 2001/097539).

In respect of Claims 72 and 73, the Examiner combines a third reference (*Dorot*) with *Torvinen* and *Fraccaroli* in respect of a rejection under 35 U.S.C. § 103(a). Therefore, it is submitted that the rejection under *Torvinen*, *Fraccaroli*, and *Dorot* is deficient for all the reasons argued above. Specifically, *Torvinen* and/or *Fraccaroli* fail to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. *Dorot* fails to cure these deficiencies. Further, it was submitted that the combination of *Torvinen* with *Fraccaroli* is improper, and it is further submitted that it is also improper to combine *Torvinen* with *Fraccaroli* and *Dorot* because *Torvinen* and *Fraccaroli* explicitly teach away from each other.

Further, the Examiner's statements of motivation to combine, found at page 14 of the Final Office Action of December 12, 2007, are again mere conclusory statements of the type prohibited under *KSR International*. Therefore, it is further submitted that the Examiner has failed to properly establish a *prima facie* case of obviousness.

Further yet, the Examiner has improperly used hindsight in his analysis (pages 4-5 of the Final Office Action of December 12, 2007). This is strictly impermissible (*In re Fine*, 837 F.2d 1071 at 1075, 5 USPQ2d 1596). Further, it is submitted that the number

of references relied on by the Examiner to reject the claims (three in the present rejection, and eight in total) is a telling indication of the impermissible use of hindsight.

For the reasons given above, the Board of Appeals is respectfully asked to reverse the rejections of Claims 72, 73, and 103-112 under 35 U.S.C. § 103(a).

Rejection of Claims 76-78 as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Griffin et al.* (U.S. Patent No. 7,072,941).

In respect of Claims 76-78, the Examiner combines a fourth reference (*Griffin*) with *Torvinen* and *Fraccaroli* in respect of a rejection under 35 U.S.C. § 103(a). Therefore, it is submitted that the rejection under *Torvinen*, *Fraccaroli*, and *Griffin* is deficient for all the reasons argued above with respect to the combination of *Torvinen* and *Fraccaroli*. Specifically, *Torvinen* and/or *Fraccaroli* fail to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. *Griffin* fails to cure these deficiencies. Further, it was submitted that the combination of *Torvinen* with *Fraccaroli* is improper, and it is further submitted that it is also improper to combine *Torvinen* with *Fraccaroli* and *Griffin* because *Torvinen* and *Fraccaroli* explicitly teach away from each other.

Further, the Examiner's statements of motivation to combine, found at page 14 of the Final Office Action of December 12, 2007, are again mere conclusory statements of the type prohibited under *KSR International*. Therefore, it is further submitted that the Examiner has failed to properly establish a *prima facie* case of obviousness.

Further yet, the Examiner has improperly used hindsight in his analysis (pages 4-5 of the Final Office action of December 12, 2007). This is strictly impermissible (*In re Fine*, 837 F.2d 1071 at 1075, 5 USPQ2d 1596). Further, it is submitted that the number

of references relied on by the Examiner to reject the claims (three in the present rejection, and eight in total) is a telling indication of the impermissible use of hindsight.

For the reasons given above, the Board of Appeals is respectfully asked to reverse the rejections of Claims 76-78 under 35 U.S.C. § 103(a).

Rejection of Claim 85 as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Laiho* (U.S. Patent No. 6,097,942).

In respect of Claim 85, the Examiner combines a fifth reference (*Laiho*) with *Torvinen* and *Fraccaroli* in respect of a rejection under 35 U.S.C. § 103(a). Therefore, it is submitted that the rejection under *Torvinen*, *Fraccaroli*, and *Laiho* is deficient for all the reasons argued above with respect to the combination of *Torvinen* and *Fraccaroli*. Specifically, *Torvinen* and/or *Fraccaroli* fail to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. *Laiho* fails to cure these deficiencies. Further, it was submitted that the combination of *Torvinen* with *Fraccaroli* is improper, and it is further submitted that it is also improper to combine *Torvinen* with *Fraccaroli* and *Laiho* because *Torvinen* and *Fraccaroli* explicitly teach away from each other.

Further, the Examiner's statements of motivation to combine, found at page 16 of the Final Office Action of December 12, 2007, are again mere conclusory statements of the type prohibited under *KSR International*. Therefore, it is further submitted that the Examiner has failed to properly establish a *prima facie* case of obviousness.

Further yet, the Examiner has improperly used hindsight in his analysis (pages 4-5 of the Final Office action of December 12, 2007). This is strictly impermissible (*In re Fine*, 837 F.2d 1071 at 1075, 5 USPQ2d 1596). Further, it is submitted that the number

of references relied on by the Examiner to reject the claims (three in the present rejection, and **eight** in total) is a telling indication of the impermissible use of hindsight.

For the reasons given above, the Board of Appeals is respectfully asked to reverse the rejection of Claim 85 under 35 U.S.C. § 103(a).

Rejection of Claim 86 as being unpatentable under 35 U.S.C. § 103 (a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Chandhok et al.* (U.S. Patent Publication No. 2004/0198376).

In respect of Claim 86, the Examiner combines a sixth reference, *Chandhok*, with *Torvinen* and *Fraccaroli* in respect of a rejection under 35 U.S.C. § 103(a). Therefore, it is submitted that the rejection under *Torvinen*, *Fraccaroli*, and *Chandhok* is deficient for all the reasons argued above with respect to the combination of *Torvinen* and *Fraccaroli*. Specifically, *Torvinen* and/or *Fraccaroli* fail to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. *Chandhok* fails to cure these deficiencies. Further, it was submitted that the combination of *Torvinen* with *Fraccaroli* is improper, and it is further submitted that it is also improper to combine *Torvinen* with *Fraccaroli* and *Chandhok* because *Torvinen* and *Fraccaroli* explicitly teach away from each other.

Further, the Examiner's statements of motivation to combine, found at page 17 of the Final Office Action of December 12, 2007, are again mere conclusory statements of the type prohibited under *KSR International*. Therefore, it is further submitted that the Examiner has failed to properly establish a *prima facie* case of obviousness.

Further yet, the Examiner has improperly used hindsight in his analysis (pages 4-5 of the Final Office action of December 12, 2007). This is strictly impermissible (*In re Fine*, 837 F.2d 1071 at 1075, 5 USPQ2d 1596). Further, it is submitted that the number

of references relied on by the Examiner to reject the claims (three in the present rejection, and **eight** in total) is a telling indication of the impermissible use of hindsight.

For the reasons given above, the Board of Appeals is respectfully asked to reverse the rejection of Claim 86 under 35 U.S.C. § 103(a).

Rejection of Claims 89-92 as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Leigh et al.* (U.S. Patent No. 5,535,426).

In respect of Claims 89-92, the Examiner combines a seventh reference, *Leigh*, with *Torvinen* and *Fraccaroli* in respect of a rejection under 35 U.S.C. § 103(a). Therefore, it is submitted that the rejection under *Torvinen*, *Fraccaroli*, and *Leigh* is deficient for all the reasons argued above with respect to the combination of *Torvinen* and *Fraccaroli*. Specifically, *Torvinen* and/or *Fraccaroli* fail to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. *Leigh* fails to cure these deficiencies. Further, it was submitted that the combination of *Torvinen* with *Fraccaroli* is improper, and it is further submitted that it is also improper to combine *Torvinen* with *Fraccaroli* and *Leigh* because *Torvinen* and *Fraccaroli* explicitly teach away from each other.

Further, the Examiner's statements of motivation to combine, found at page 18 of the Final Office Action of December 12, 2007, are again mere conclusory statements of the type prohibited under *KSR International*. Therefore, it is further submitted that the Examiner has failed to properly establish a *prima facie* case of obviousness.

Further yet, the Examiner has improperly used hindsight in his analysis (pages 4-5 of the Final Office action of December 12, 2007). This is strictly impermissible (*In re Fine*, 837 F.2d 1071 at 1075, 5 USPQ2d 1596). Further, it is submitted that the number

of references relied on by the Examiner to reject the claims (three in the present rejection, and eight in total) is a telling indication of the impermissible use of hindsight.

For the reasons given above, the Board of Appeals is respectfully asked to reverse the rejections of Claims 89-92 under 35 U.S.C. § 103(a).

Rejection of Claim 93 as being unpatentable under 35 U.S.C. § 103(a) over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Requena* (U.S. Patent Publication No. 2002/0126701).

In respect of Claim 93, the Examiner combines an eighth reference, *Requena*, with *Torvinen* and *Fraccaroli* in respect of a rejection under 35 U.S.C. § 103(a). Therefore, it is submitted that the rejection under *Torvinen*, *Fraccaroli*, and *Requena* is deficient for all the reasons argued above with respect to the combination of *Torvinen* and *Fraccaroli*. Specifically, *Torvinen* and/or *Fraccaroli* fail to teach or suggest a method that includes the steps of publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group, where the at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. *Requena* fails to cure these deficiencies. Further, it was submitted that the combination of *Torvinen* with *Fraccaroli* is improper, and it is further submitted that it is also improper to combine *Torvinen* with *Fraccaroli* and *Requena* because *Torvinen* and *Fraccaroli* explicitly teach away from each other.

Further, the Examiner's statements of motivation to combine, found at page 20 of the Final Office Action of December 12, 2007, are again mere conclusory statements of the type prohibited under *KSR International*. Therefore, it is further submitted that the Examiner has failed to properly establish a *prima facie* case of obviousness.

Further yet, the Examiner has improperly used hindsight in his analysis (pages 4-5 of the Final Office action of December 12, 2007). This is strictly impermissible (*In re Fine*, 837 F.2d 1071 at 1075, 5 USPQ2d 1596). Further, it is submitted that the number

APPEAL BRIEF

Application Serial No. 10/825,972

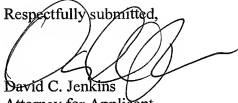
of references relied on by the Examiner to reject the claims (three in the present rejection, and eight in total) is a telling indication of the impermissible use of hindsight.

For the reasons given above, the Board of Appeals is respectfully asked to reverse the rejection of Claim 93 under 35 U.S.C. § 103(a).

Conclusion

It is submitted that Claims 65-117 are patentable over the prior art. Therefore, it is respectfully requested that the Board reverse the Examiner's rejections of Claims 65-117 and remand the application to the Examiner for the issuance of a Notice of Allowance.

Respectfully submitted,



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Claims Appendix

Claim 1-64 (Previously Cancelled)

Claim 65 (Previously Presented): A method of creating and managing a group of mobile stations for a communication session in a communications network, the communication session being one in which users of respective mobile stations communicate with one another, the method comprising:

publishing information about one or more particular users of respective mobile stations to the communications network; and

receiving at least one rule defining a member of the group, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations, the at least one rule being received in association with a group address; and

dynamically populating the group with members, the populating comprising:

determining mobile stations having respective users with published information on the communications network that matches the published information criteria of the at least one rule; and

populating the group with the mobile stations having respective users with published information on the communications network that matches the published information criteria of the at least one rule.

Claim 66 (Previously Presented): The method of claim 65, wherein the published information criteria of the at least one rule comprises at least one characteristic of respective users of mobile stations.

Claim 67 (Previously Presented): The method of claim 65, wherein the published information criteria of the at least one rule comprises at least one personal preference and/or at least one common interest of respective users of mobile stations.

Claim 68 (Previously Presented): The method of claim 65, wherein the published information criteria of the at least one rule comprises published location information of respective users of mobile stations.

Claim 69 (Previously Presented): The method of claim 65, wherein the at least one rule is further defined by a group of pre-selected mobile stations from which to define the group.

Claim 70 (Previously Presented): The method of claim 65, wherein the at least one rule further defined by additional criteria comprising location information about mobile stations managed by the communications network, the step of dynamically populating the group further comprising:

determining if the location information about the one or more particular mobile stations matches the location information criteria of the at least one rule; and

wherein the group is populated with members consisting of mobile stations having respective users with published information on the communications network and location information that matches the published information criteria and location information criteria of the at least one rule respectively.

Claim 71 (Previously Presented): The method of claim 70, wherein the location information about the one or more particular mobile stations is stored on one or more network servers.

Claim 72 (Previously Presented): The method of claim 70, wherein the location information about the one or more particular mobile stations is stored on one or more network servers in Xtensible Markup Language (XML) format.

Claim 73 (Previously Presented): The method of claim 65, wherein the at least one rule is stored on one or more network servers in Xtensible Markup Language (XML) format.

APPEAL BRIEF
Application Serial No. 10/825,972

Claim 74 (Previously Presented): The method of claim 65, further comprising sending a notification to each member of the group in response to the populating, the notification identifying the respective mobile station or its user as a member of the group.

Claim 75 (Previously Presented): The method of claim 74, wherein the notification identifying at least some of the other mobile stations or users of respective membership as members of the group.

Claim 76 (Previously Presented): The method of claim 75, wherein the notification excludes anonymous members of the group.

Claim 77 (Previously Presented): The method of claim 76, further comprising sending a notification to each member of the group identifying an anonymous member of the group when the anonymous member actively participates in the group.

Claim 78 (Previously Presented): The method of claim 65, wherein one or more members of the group may be anonymous members in accordance with the published information about the one or more particular users on the communications network, the at least one rule defining capabilities of anonymous members to passively and/or actively participates in the group.

Claim 79 (Previously Presented): The method of claim 65, comprising receiving two or more rules defining a member of the group, the two or more rules being received in association with a common group address, the group being dynamically populated with members in accordance with the two or more rules and at least the published information about the one or more particular users on the communications network.

Claim 80 (Previously Presented): The method of claim 79, wherein one of the two or more rules is defined by criteria comprising location information managed by the communications network, the group being dynamically populated with members in accordance with the two or more rules, published information about one or more particular users on the communications network, and location information about one or more particular mobile stations of the communications network.

APPEAL BRIEF
Application Serial No. 10/825,972

Claim 81 (Previously Presented): The method of claim 65, wherein the step of determining comprises requesting and receiving notification of one or more particular mobile stations which match the at least one rule.

Claim 82 (Previously Presented): The method of claim 81, wherein the step of determining comprises requesting and receiving notification that no particular mobile stations match the at least one rule.

Claim 83 (Previously Presented): The method of claim 81, further comprising subscribing to at least one server which provides notification that one or more particular mobile stations match the at least one rule.

Claim 84 (Previously Presented): The method of claim 83, further comprising determining an address for each of the at least one server for subscribing, the address being determined from a resource list of addresses for such servers.

Claim 85 (Previously Presented): The method of claim 81, further comprising receiving notification of individual matching mobile stations as the individual matching mobile stations are determined by the at least one server to hasten the populating.

Claim 86 (Previously Presented): The method of claim 65, further comprising maintaining the group, removing one or more particular mobile stations or users as a member of the group in accordance with the at least one rule.

Claim 87 (Previously Presented): The method of claim 86, further comprising receiving notification that one or more particular mobile stations or users no longer matches the at least one rule.

Claim 88 (Previously Presented): The method of claim 65, further comprising receiving a change of the at least one rule and managing the members of the group in accordance with the change wherein the step of managing comprises at least one of adding and removing members to the group.

APPEAL BRIEF
Application Serial No. 10/825,972

Claim 89 (Previously Presented): The method of claim 65, further comprising extending a search for mobile stations matching the at least one rule.

Claim 90 (Previously Presented): The method of claim 89, wherein the subscribing to at least one server extends the search to at least one of different domains and networks.

Claim 91 (Previously Presented): The method of claim 83, further comprising further subscribing by one or more of the at least one server to one or more other such servers to extend a search for mobile stations matching the at least one rule.

Claim 92 (Previously Presented): The method of claim 91, wherein the further subscribing extends the search for mobile stations to comprise a home network and a roaming network of a first mobile station.

Claim 93 (Previously Presented): The method of claim 65, wherein the group comprises a mayday group and the method comprises:

receiving a request from a first mobile station to initiate a group communication with at least one second communication device proximate to the first mobile station; and

populating the mayday group with particular ones of the mobile stations determined in response to pre-defined rules for the mayday group.

Claim 94 (Previously Presented): A server for creating and managing a group of mobile stations for a communication session in a communications network, the communication session being one in which users of respective mobile stations communicate with one another, the server comprising:

a communication system for transmitting and receiving messages via the communications network;

a processor coupled to the communication system for processing messages; and

memory coupled to the processor for storing instructions to configure the processor to:

publish information about one or more particular users of respective mobile stations to the communications network; and

receive at least one rule defining a member of the group, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations, the at least one rule being received in association with a group address; and

dynamically populate the group with members, the populating comprising:

determining mobile stations having respective users with published information on the communications network that matches the published information criteria of the at least one rule; and

populating the group with the mobile stations having respective users with published information on the communications network that matches the published information criteria of the at least one rule.

Claim 95 (Previously Presented): The server of claim 94, wherein the memory further stores instructions to configure the processor to wherein the published information criteria of the at least one rule comprises at least one characteristic of respective users of mobile stations.

Claim 96 (Previously Presented): The server of claim 94, wherein the memory further stores instructions to configure the processor to wherein the published information criteria of the at least one rule comprises at least one personal preference and/or at least one common interest of respective users of mobile stations.

Claim 97 (Previously Presented): The server of claim 94, wherein the memory further stores instructions to configure the processor to wherein the published information criteria of the at least one rule comprises published location information of respective users of mobile stations.

APPEAL BRIEF
Application Serial No. 10/825,972

Claim 98 (Previously Presented): The server of claim 94, wherein the memory further stores instructions to configure the processor to wherein the at least one rule is further defined by a group of pre-selected mobile stations from which to define the group.

Claim 99 (Previously Presented): The server of claim 94, wherein the at least one rule further defined by additional criteria comprising location information managed by the communications network, the step of dynamically populating the group further comprising:

determining if the location information about the one or more particular mobile stations matches the location information criteria of the at least one rule;
and

wherein the group is populated with members consisting of mobile stations having respective users with published information on the communications network and location information that matches the published information criteria and location information criteria of the at least one rule respectively.

Claim 100 (Previously Presented): The server of claim 99, wherein the location information about the one or more particular mobile stations is stored on one or more network servers.

Claim 101 (Previously Presented): The server of claim 99, wherein the location information about the one or more particular mobile stations is stored on one or more network servers in Xtensible Markup Language (XML) format.

Claim 102 (Previously Presented): The server of claim 94, wherein the at least one rule is stored on one or more network servers in Xtensible Markup Language (XML) format.

Claim 103 (Previously Presented): A method of operating a server for creating and managing a group of mobile stations for a communication session in a communications network, the communication session being one in which users of respective mobile stations communicate with one another, the method comprising:

publishing information about one or more particular users of respective mobile stations to the communications network; and

receiving at least one rule defining a member of the group, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations, the at least one rule being received in association with a group address; and

dynamically populating the group with members, the populating comprising:

determining mobile stations having respective users with published information on the communications network that matches the published information criteria of the at least one rule; and

populating the group with the mobile stations having respective users with published information on the communications network that matches the published information criteria of the at least one rule.

Claim 104 (Previously Presented): A mobile station for initiating a communication session among other mobile stations in a communication network, the communication session being one in which users of respective mobile stations communicate with one another, the mobile station comprising:

a transceiver adapted to transmit and receive messages via the communication network;

a processor coupled to the transceiver, the processor adapted to process messages; and

a memory coupled to the processor, the memory adapted to store instructions to configure the processor to:

transmit, to a server adapted to create and manage a group of mobile stations, information to be published to the communications network about one or more particular users of respective mobile stations; and

transmit at least one rule defining a member of the group to the server, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations,

wherein the at least one rule is associated with a group address and is used to populate the group with members consisting of mobile stations having respective users having published information about the one or more particular users on the communications network that matches the published information criteria of the at least one rule.

Claim 105 (Previously Presented): The mobile station of claim 104, wherein the memory is further adapted to store instructions to configure the processor to transmit information to the server for publication comprising at least one characteristic of the user of the mobile station.

Claim 106 (Previously Presented): The mobile station of claim 104, wherein the memory is further adapted to store instructions to configure the processor to transmit information to the server for publication comprising at least one personal preference and/or at least one common interest of the user of the mobile station.

Claim 107 (Previously Presented): The mobile station of claim 104, wherein the memory is further adapted to store instructions to configure the processor to transmit information to the server for publication comprising at published location information of the user of the mobile station.

Claim 108 (Previously Presented): The mobile station of claim 104, wherein the memory is further adapted to store instructions to configure the processor to transmit the at least one rule being further defined by a group of pre-selected mobile stations from which to define the group.

Claim 109 (Previously Presented): The mobile station of claim 104, wherein the memory is further adapted to store instructions to configure the processor to transmit the at least one rule being further defined by additional criteria comprising location information, wherein the location information is used to determine whether the one or more particular mobile stations matches the location information criteria of the at least one rule, and

the group is populated with members consisting of mobile stations having respective users with published information on the communications network and location information that matches the published information criteria and location information criteria of the at least one rule respectively.

Claim 110 (Previously Presented): The mobile station of claim 109, wherein the location information about the one or more particular mobile stations is stored on one or more network servers.

Claim 111 (Previously Presented): The mobile station of claim 109, wherein the location information about the one or more particular mobile stations is stored on one or more network servers in Xtensible Markup Language (XML) format.

Claim 112 (Previously Presented): The mobile station of claim 104, wherein the at least one rule is stored on one or more network servers in Xtensible Markup Language (XML) format.

Claim 113 (Previously Presented): A method of operating a mobile station for initiating a communication session among other mobile stations in a communication network, the communication session being one in which users of respective mobile stations communicate with one another, the method comprising:

transmitting information about one or more particular users of respective mobile stations to a server adapted to create and manage a group for publishing to the communications network; and

transmitting the at least one rule defining a member of the group to the server, the at least one rule defining group members based on criteria comprising published information about respective users of mobile stations,

wherein the at least one rule is associated with a group address and is used to populate the group with members consisting of mobile stations having respective users having published information about the one or more particular users on the communications network matches the published information criteria of the at least one rule.

Claim 114 (Previously Presented): A method of creating and managing a group of mobile stations for a communication session in a communications network, the communication session being one in which users of respective mobile stations communicate with one another, the group being associated with a group address and being defined by at least one rule, the method comprising:

publishing an interest of one or more users to the communications network; and

determining mobile stations having respective users with an interest published to the communications network which matches an interest for participating in the group defined by the at least one rule; and

dynamically populating the group with members comprising mobile stations having respective users with an interest published to the communications network which matches the interest for participating in the group defined by the at least one rule.

Claims 115 (Previously Presented). The method of claim 114, wherein the publishing step comprises publishing an interest in participating in a particular dynamic group or an interest in participating in dynamic groups generally.

Claim 116 (Previously Presented): The method of claim 114, wherein the publishing step comprises publishing an interest comprises at least one personal preference and/or at least one common interest of respective user.

APPEAL BRIEF

Application Serial No. 10/825,972

Claim 117 (Previously Presented): The method of claim 114, wherein mobile stations are determined from a subset of pre-selected mobile stations or pre-selected users of the mobile stations.

Evidence Appendix

None.

APPEAL BRIEF
Application Serial No. 10/825,972

Related Proceedings Appendix

None.